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Hearing:
13 September 2005

Mailed:
8 February 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SmithKline Beecham Corporation
v.
Moba, Inc.

Opposition No. 91155236
to application Serial No. 76332839

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Gregory P. Goonan of The Affinity Law Group for Moba, Inc.¹

Before Hairston, Grendel, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 2, 2001, Moba, Inc. (applicant) applied to register on the Principal Register the mark MR. TUMEE in standard character form for "vitamins and nutritional supplements" in Class 5.² After the mark was published for opposition, opposer (SmithKline Beecham Corporation), on

¹ Applicant's counsel did not file a brief but did represent applicant at the oral argument.

² Serial No. 76332839 is based on an allegation of a bona fide intention to use the mark in commerce.

Opposition No. 91155236

November 13, 2002, filed a notice of opposition. The opposition is based on opposer's allegation of a likelihood of confusion under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) with numerous registrations owned by opposer. The relevant registrations are set out below.

I.

No. 1,979,915

The logo for TUMS, featuring the word "TUMS" in a stylized, outlined, blocky font.

For: Antacids and calcium supplements in Class 5
Issued: 11 June 1996, Section 8 & 15

II.

No. 2,468,509

TUMS CALCIUM FOR LIFE (Standard character form)

For: Dietary Supplements in Class 5

Issued : 10 July 2001

Disclaimer: "Calcium"

III.

No. 2,483,575

TUMS 70 YEARS STRONG 1930-2000 and design

For: Antacids and calcium supplements in Class 5

Issued: 28 August 2001

Disclaimer: "1930" and "2000"

IV.

No. 2,480,800

TUMS 70 YEARS STRONG! (Standard character form)

For: Antacids and calcium supplements in Class 5

Issued: 21 August 2001

V.

No. 2,076,469



For: Antacids and calcium supplements in Class 5
Issued: 01 July 1977, Section 8 & 15

VI.

No. 2,240,777

TUMS (standard character form)

For: Antacids, calcium supplements and preparations
for premenstrual balance in Class 5.

Issued: 20 April 1999, Section 8 & 15

VII.

No. 1,979,916

TUMS (standard character form)

For: Antacids and calcium supplements in Class 5

Issued: 11 June 1996, Section 8 & 15

VIII.

No. 680,675

TUMS FOR THE TUMMY (standard character form)

For: Carminative antacids in Class 5.

Issued: 23 June 1959, second renewal

IX.

No. 268,593



For: Carminative antacid corrective for stomach
distress in Class 5

Issued: 18 March 1930, fourth renewal³

³ While Office electronic records refer to the 09 November 2000 renewal as the "Third Renewal," this appears to be an oversight because the 26 March 1990 renewal is also referred to as a "Third Renewal."

X.

No. 1,902,115

TUMS ULTRA (standard character form)

For: Antacids and calcium supplements in Class 5

Issued: 27 June 1995, Section 8 & 15⁴

Applicant denied the salient allegations of opposer's notice of opposition. An oral hearing was held on September 13, 2005.

The Record

The record consists of the pleadings; the file of the involved application; the testimonial deposition of Mark R. Prus, opposer's director of marketing, with exhibits; the stipulated testimony of Christopher A. Sidoti, opposer's assistant secretary, with exhibit; the testimonial deposition, with exhibits, of Viken Momdjian, applicant's president; applicant's notice of reliance that included the discovery deposition, with exhibits, of Paul A. Wardle, opposer's operations manager, opposer's discovery responses, and copies of federal trademark registrations and a file history of one of the registered marks; and opposer's notice of reliance on status and title copies of its trademark registrations.

⁴ Opposer also alleged ownership of Registration Nos. 2,240,835 (TUMS ULTRA CALCIUM and label design); 2,240,778 (TUMS CALCIUM and label design); and 2,240,839 (TUMS E-X CALCIUM and label design). However, Office records indicate that Section 8 affidavits have not been filed in these registrations and the period to file a Section 8 affidavit has expired. In order to not delay the case to wait for the outcome of these registrations, we will not consider these registrations further.

Preliminary Matters

Inasmuch as opposer has submitted status and title copies of its federal trademark registrations for various TUMS marks,⁵ we find that opposer has established its standing to oppose. See, e.g., Lipton Industries, Inc. v. Ralston Purina Company, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, in view of applicant's ownership of these registrations, priority is not an issue here. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

The central issue in this case is whether applicant's mark for its goods is confusingly similar to opposer's marks used on the identified goods. We analyze the question of likelihood of confusion by looking at the evidence as it relates to the thirteen factors set out by the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed.

⁵ Mr. Sidoti, in his stipulated testimony, explained that SmithKline Beecham plc (SB) merged with Glaxo Wellcome, plc to become GlaxoSmithKline plc. SB remains "a separate and independent corporation up to and including the present time." Sidoti, p.1. Furthermore, while GlaxoSmithKline "actually uses the mark" for "business reasons, it has been determined that the ownership of the trademark registrations in the United States for the various TUMS marks should be in the name of SB." Sidoti, p.2.

Cir. 2003) and In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

We begin by comparing the similarity or dissimilarity of the goods. Applicant's goods are identified as vitamins and nutritional supplements. Opposer's goods in its registrations are identified as antacids and calcium supplements (Nos. 1,979,915; 2,483,575; 2,480,800; 2,076,469; 2,240,777; 1,979,916; and 1,902,115), dietary supplements (No. 2,468,509), preparations for premenstrual balance (2,240,777), and carminative antacids (Nos. 268,593 and 680,675). For these TUMS products, the "primary active ingredient is calcium carbonate." Wardle dep. at 35. "Calcium supplements are dietary supplements." Wardle dep. at 25. "In terms of the amount of calcium carbonate in the products, the regular strength has the least amount of calcium carbonate, it's a smaller tablet, the extra strength has more calcium carbonate, the Tums Calcium for Life has even more." Wardle dep. at 37. Calcium carbonate is the substance that has antacid properties. Wardle dep. at 39. Furthermore, all of opposer's subbrands except Calcium for Life and Lasting Effects are "intended to be used both as antacids and calcium supplements." Wardle dep. at 56. "But all of the products contain calcium and are a good source of calcium." Wardle dep. at 57.

Applicant's goods are "vitamins and nutritional supplements." Applicant's products include a "Mr. Tume's Calcium plus Vitamin D product." Momdjian dep. at 32. Applicant's nutritional supplements include calcium supplements. Therefore, to the extent that applicant's and opposer's goods include calcium supplements, they are identical. Both applicant and opposer also sell other vitamin products. Wardle dep. at 165-66.⁶ Therefore, applicant's vitamin and other nutritional products would also be related to opposer's calcium supplements. These vitamins and various nutritional supplements would be sold under similar conditions and prospective purchasers would assume that the same source would provide both vitamins and various nutritional supplements. McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989) (Goods do not have to be identical. "It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources"). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). Therefore, even to the extent that the goods are not identical, we find

⁶ While some material on the page is marked as confidential, the fact that opposer publicly sells vitamins does not appear to be confidential.

that calcium supplements and vitamins and nutritional supplements are related.

We also consider the channels of trade and prospective purchasers. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). Inasmuch as there are no restrictions in either the application or the registrations, we must assume that the goods travel in all the normal channels of trade for the goods. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). See also Morton-Norwich Products, Inc. v. N. Siperstein, Inc., 222 USPQ 735, 736 (TTAB 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in all channels of trade that would

be normal for such goods, and that the goods would be purchased by all potential customers"). Therefore, we must consider that applicant's and opposer's calcium supplements travel in the identical channels of trade and that potential purchasers would be, at the minimum, overlapping.

Regarding the actual channels of trade, we note that opposer's Tums products are sold "almost anywhere." Wardle dep. at 61.

It's sold in drugstore, grocery stores, pharmacy, pharmacy outlets, places like Wal-Mart, Target; it's sold in C[onvenience] stores, so your rural corner shop it's sold in; hotel stores, nontraditional kind of retail outlets; it's sold in gas station outlets; it's sold in vending machines in some places. So literally almost anywhere you can buy a product it has been sold. We have sold it in some clothing outlets, for example, there's a baby store that we've sold Tums in. We have sold it in a lot of places... I've seen it in animal feed stores.

Wardle dep. at 61.

Applicant has identified pharmacies, supermarkets, and other retail outlets as places it intends to market its product in the United States. Momdjian dep. at 58.

Therefore, the actual channels of trade and the prospective purchasers are expected to be overlapping.

While neither party in its identification of goods limits its supplements to any particular type of calcium supplements, channels of trade, or purchasers, during the trial the evidence indicated that applicant's products are primarily designed for children while opposer's products are

marketed primarily for adults. As noted above, this is not significant since neither party limits its goods in the application or registrations. Therefore, we must assume that applicant's and opposer's calcium supplements are marketed for children and adults. Furthermore, even if we did take this into consideration, the products would still overlap. Applicant's witness agreed that "Mr. Tumee's line of products is used by children 4 through 14 approximately." Momdjian dep. at 56. Furthermore, in response to the question: "So adults can use it [applicant's products] as well as children?" applicant's witness responded: "Yes, they can." Momdjian dep. at 57. Opposer described its marketing as follows:

[W]e don't actively market to children under two and I think children under two would find it very difficult to take Tums. Our marketing is for ages 12 and above. Under age 12 is considered pediatric use by the FDA and we don't actively market to children under 12. Apart from being functionally able to take Tums I'm not aware of any exclusions or people who should not take Tums unless of course their doctor advises them not to for whatever reason.

Prus dep. at 28-29.

Even as actually marketed, both products target an overlapping market (ages 12-14) and opposer's products can be taken by younger children and applicant's products can be used by older children and adults. Furthermore, the purchasers of both products would still overlap since parents are likely to purchase supplements for themselves

and their children. Finally, while the testimony was sweepingly designated as "confidential," opposer's witness (Wardle) discussed plans "to expand its product line under the TUMS mark." Opposer's Brief at 12.

We now address whether the marks of the parties are similar. Applicant seeks to register the mark MR. TUMEE and opposer relies on numerous registrations for the term TUMS. Applicant's mark is shown as a standard character drawing and several of opposer's marks are also depicted without any specific style or design. When we compare the marks, MR. TUMEE and TUMS, it is clear that they are similar to the extent that they both contain the same three letters (TUM), which is virtually opposer's entire mark except for the letter "S" to make the term a plural. They are otherwise different because applicant adds the title "Mr." and the diminutive "-ee." Applicant's literature emphasizes the "Tumee" portion of its mark inasmuch as it sometimes refers to its products as simply "Tumees." See Momdjian dep. at 66 ("Mr. Tumee is the brand name, whenever we refer to the brand name we use Mr. Tumee and whenever we refer to the individual Gumee we refer to it as Tumees"). We also add that "tummy" is an informal term for "stomach."⁷ Therefore, the term would have some suggestive connotation even for a

⁷ *Random House Unabridged Dictionary* (2d ed.). Applicant's notice of reliance.

calcium supplement that is ingested orally. In addition, opposer has a registration for the mark TUMS FOR THE TUMMY for carminative antacids. When we examine the similarities and dissimilarities of the marks in appearance, sound, meaning, and commercial impression, they are obviously not identical. They look somewhat similar since they feature "TUM" as a prominent part of both marks. Their meanings would have a similar suggestive meaning referring to the stomach. Their commercial impressions would have some similarity especially since purchasers would likely believe that opposer's TUMS and TUMS FOR THE TUMMY⁸ calcium supplements and antacids are now available for children. See Proctor & Gamble Co. v. Conway, 419 F.2d 1332, 164 USPQ 301, 304 (CCPA 1970) (MISTER STAIN and MR. CLEAN similar despite their obvious differences. "A designation may well be likely to cause purchaser confusion as to the origin of goods because it conveys, as used, the same idea, or stimulates the same mental reaction, or in the ultimate has the same meaning"). See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281,

⁸ We note that applicant elicited testimony from opposer's witness that the witness had no personal knowledge of any use of the phrase "Tums for the Tummy" on Tums products. Prus dep. at 77-78. "The law, of course, is well settled that an applicant cannot collaterally attack opposer's registration in the absence of a counterclaim for cancellation. 37 CFR §2.106(b); Contour Chair-Lounge Co. v. The Englander Co., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963)." NASDAQ Stock Market Inc. v. Antarctica S.r.l., 69 USPQ2d 1718, 1736 (TTAB 2003). Therefore, we must assume that opposer's registration is valid.

1283 (Fed. Cir. 1984) ("It is the similarity of commercial impression between SPICE VALLEY and SPICE ISLANDS that weights heavily against the applicant"); International House of Pancakes, Inc. v. Elca, Corp., 216 USPQ 521, 525 (TTAB 1982) (Likelihood of confusion between INTERNATIONAL HOUSE OF PANCAKES and COLONIAL HOUSE OF PANCAKES). We add that this is not a case in which the common term is a generic or non-distinctive term. See, e.g., Kellogg Co. v. Pack 'Em Enters, Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (FROOTEE ICE for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products); Keebler Co. v. Murray Bakery Prods. Inc., 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (PECAN SHORTIES not likely to cause confusion with PECAN SANDIES for cookies). Taken together, we conclude that opposer's marks TUMS and TUMS FOR THE TUMMY and applicant's mark MR. TUMEE are slightly more similar than they are different.

Another factor that has considerable importance in this case is the question of fame or public recognition and renown. The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting, Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d

1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for "natural agricultural products, namely, edible dog treats" confusingly similar to FRITO-LAY for snack foods).

Opposer has presented evidence of the public recognition and renown of its TUMS mark. Opposer's witness testified as follows:

A. Yes. Periodically we will do awareness studies which would ask people on an unaided basis to name antacids or calcium supplements and Tums is mentioned quite frequently.

Q. Do you have any idea on an average basis of what kind of unaided awareness you get on these studies?

A. It will vary per study, but is in the neighborhood of 80 percent.

Q. That's an unaided awareness.

A. Yes.

Q. Do you do aided awareness studies as well?

A. Yes.

Q. What are the results for that?

A. About 99 percent or even in some studies 100 percent of people are aware of Tums on an aided basis. For example if you ask them if they have ever heard of Tums virtually everyone has.

Prus dep. at 43-44.

Opposer's witness also testified that TUMS "is in more households than any other OTC [Over-the-Counter] product except Tylenol, so it is very broadly distributed and Tums

can be used by 95 year-olds, it can be used by 18 year-olds or 45 year-olds, male, female. It is very broadly used." Prus dep. at 26-27. In addition, opposer's retail sales are approximately \$200 million (Wardle dep. at 62 and 126) and its advertising expenses in 2002 were estimated to be in the \$40-50 million range. Prus dep. at 73. It advertises on television, print, radio, and the Internet. Id. Based on this evidence, which consists of the unrebutted testimony of opposer's witnesses, we resolve the fame factor in opposer's favor.

Opposer's witness also testified that there "are impulse purchases of Tums and there are planned purchases of Tums." Prus dep. at 53. "There are also instances where we have displays in the store or special advertising on a shelf that might trigger someone, oh, yes, I'm running low on antacids or Tums or calcium supplements and I need to buy some more." Id. at 54. Therefore, this factor also favors opposer.

Regarding actual confusion, we note that there is no evidence of actual confusion but this is not normally significant. The absence of actual confusion does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).

Here, applicant has filed an intent-to-use application and applicant did not even anticipate distributing products in the United States until the second half of 2005. Momdjian dep. at 54.

We also add that applicant has submitted copies of several third-party registrations, apparently as evidence that it likewise should be entitled to register its mark. The Federal Circuit addressed the issue of third-party registrations in likelihood of confusion cases as follows: "Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"). However, we can use the third-party registrations as a form of dictionary to show how the term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). Even when we consider the registrations in this light, it merely

highlights the fact that "tummy" is a term with some suggestive significance when used in association with dietary supplements or antacids. However, these registrations do not demonstrate that the mark TUMS is entitled to a narrow scope of protection.

Finally, we must balance the factors to determine if there is a likelihood of confusion in this case. We readily admit that this is a close case on this question. The marks TUMS and MR. TUMEE overlap to the extent that they both contain the same letters T-U-M. Applicant adds the title "Mr." and the diminutive "-ee." However, opposer also has a registration for the mark TUMS FOR THE TUMMY, which has even more in common with MR. TUMEE. The marks have enough similarities to conclude that the marks are not dissimilar. Many of the other factors strongly favor opposer. The goods are in part identical, opposer is considering expanding the breath of its TUMS product line, opposer's mark has achieved significant public recognition and renown, purchasers may be impulse purchasers, and the goods are sold at least in overlapping channels of trade and to the identical purchasers. We have been instructed in cases such as this where we have doubts on the issue of likelihood of confusion, that we must resolve them in favor of the prior registrant and against the newcomer. Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1003

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(Fed. Cir, 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks"). See also In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). We do that in this case.

Decision: The opposition is sustained and registration to applicant of its mark is refused.